

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 87

Olm

MAILED

UNITED STATES PATENT AND TRADEMARK OFFICE

JUL 27 1999

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEAN-YVES CHENARD and JEAN-CLAUDE MENDELSONH

Appeal No. 95-1963
Application No. 07/870,759¹

HEARD: February 12, 1999

Before KIMLIN, OWENS and SPIEGEL, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

REQUEST FOR REHEARING

Appellants request rehearing of our decision of February 23, 1999, wherein we affirmed the examiner's rejection

¹ Application for patent filed April 20, 1992. According to appellants, this application is a continuation of Application No. 07/633,187, filed December 28, 1990; which is a continuation of Application No. 07/273,669, filed November 18, 1988; which is a continuation of Application No. 06/254,313, filed April 15, 1981; which is a continuation-in-part of Application No. 06/070,503, filed August 28, 1979; all which have been abandoned.

Appeal No. 95-1963
Application No. 07/870,759

of the appealed claims under 35 U.S.C. § 103 as being unpatentable over the collective teachings of Gough, Stapfer, Hechenbleiker '129 and '527, Wowk, Schroeder, Weinberg '750 and Kauder '915.

We have carefully considered each of the arguments presented in appellants' request, but we remain of the opinion that the examiner's § 103 rejection is supported by the prior art evidence relied upon.

Appellants state at page 2 of the Request that "[t]he Board mischaracterizes Gough as disclosing that 'it was known in the art to employ synergistic combinations of organic thiols and organotin mercaptides as stabilizers for vinyl halide polymers'" (see pages 13 and 14 of our decision). We agree with appellants that Gough does not expressly teach synergistic combinations of organic thiols and organotin mercaptides. However, the thrust of our reasoning is that when the BACKGROUND section of Gough is read in light of the secondary references, one of ordinary skill in the art would have found it obvious to employ a combination of organic thiols and organotin mercaptides as stabilizers for vinyl halide polymers. Gough discloses that it was known in the art to use organic thiols and organotin mercaptides to inhibit or prevent discoloration of vinyl halide polymers. Accordingly, it

Appeal No. 95-1963
Application No. 07/870,759

would have been obvious for one of ordinary skill in the art to utilize the organic thiols and organotin mercaptides in combination. In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980). Furthermore, Stapfer discloses that a combination of organotin mercaptides and organic thio compounds produces synergistic results in stabilizing vinyl halide polymers. Accordingly, based on these collective teachings, we find that one of ordinary skill in the art would have had a reasonable expectation of obtaining a synergistic effect when utilizing organic thiols and organotin mercaptides as stabilizers in vinyl halide polymers. In addition, both Schroeder and Wowk teach the stabilization of vinyl halide polymers by incorporating therein organotin halides.

Appellants also submit at pages 3 and 4 of their Request that we mischaracterized Stapfer as "a further teaching that it was known in the art that a combination of organotin mercaptides and organic thiols provides synergistic stabilization of vinyl halide resins" (see page 14 of Decision). However, appellants acknowledge at page 5 of the Request that "Stapfer also discloses several thiol compounds as examples of suitable organic thio compounds, for example, poly(diethylene glycol) ethylidene-bis-mercaptoethanol." Also, Stapfer expressly discloses organotin

mercaptides as a class of compounds that synergistically combine with organic thio compounds to stabilize vinyl halide polymers (see column 11). Accordingly, we do not understand appellants' statement at page 4 of the Request that Stapfer "does not disclose such a combination," unless appellants mean that the reference does not specifically exemplify the stated combination.

We also do not subscribe to appellants' position that Gough's disclosure of superior results for a stabilizer combination of an organotin borate and an organic thiol compound represents a teaching away from the presently claimed combination of stabilizers. As explained in our decision, simply because the prior art teaches that a specific combination is superior to other combinations of known compounds, it does not follow that the purported inferior combinations would have been nonobvious to one of ordinary skill in the art. Certainly, the superiority of one stabilizer over another does not render the latter ineffective or useless. While appellants contend at page 9 of the Request that "there is no motivation whatsoever to replace the organotin borate of Gough with the broader class of organotins disclosed in Stapfer," the mere commercial unavailability or potential cost of the organotin borates would provide ample motivation.

Appeal No. 95-1963
Application No. 07/870,759

Finally, appellants maintain at page 12 of their Request that "[t]he Board neglected to carefully consider the Rule 132 evidence submitted by Appellants during prosecution as it applies to the separate groupings of claims, namely the sulfur organotin and halogen organotin claims on appeal." However, as noted in our decision, in devoting only two sentences to the merits of the declaration at page 35 of the Brief, appellants fail to satisfy their burden of explaining the significance and content of the declaration data. It is not within the province of the Board to ferret out data from an applicant's specification or declarations in a light that is most favorable to the applicant's position. Furthermore, for the reasons stated in our decision, we did not find that the declaration data presented a proper comparison with the closest prior art or established unexpected results that were commensurate in scope with the considerable breadth of the appealed claims.

In conclusion, based on the foregoing, appellants' request is denied with respect to making any change in our original decision.

Appeal No. 95-1963
Application No. 07/870,759

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

DENIED

Edward C. Kimlin
EDWARD C. KIMLIN)
Administrative Patent Judge)
)
)
)
)
Terry J. Owens)
TERRY J. OWENS) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
)
)
Carol A. Spiegel)
CAROL A. SPIEGEL)
Administrative Patent Judge)

clm

Appeal No. 95-1963
Application No. 07/870,759

Finnegan, Henderson, Farabow, Garrett
and Dunner
1300 I St., N.W.
Washington, DC 20005-3315